

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)	
Joubert Berger, et <i>al.</i>)	Confirmation No. 7770
Application No. 10/013,043)	Group Art Unit: 2191
Filed: October 30, 2001)	Examiner: Nahar, Qamrun
For: System and Method for Installing)	
<u>Applications in a Trusted Environment</u>)	

REQUEST TO VACATE ORDER

RETURNING UNDOCKETED APPEAL TO EXAMINER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In February 2007 this application was appealed to the Board of Patent Appeals and Interferences after a Final Rejection. Then, on July 13, 2009, the Board returned the application to the examiner since “a review of the application has revealed that the application is not ready for docketing as an appeal.” In particular the Board indicated that the Appeal Brief filed April 5, 2007 (“Third Appeal Brief”) was inconsistent with an amendment filed on January 21, 2005. Claims 2 and 5 in the appendix of the Appeal Brief were not consistent with that earlier amendment. The Board ordered that Appellant submit a “paper” to correct the Claims Appendix in the (Third) Appeal Brief.

REMARKS

A careful inspection of section VIII (the Claims Appendix) of the Third Appeal Brief reveals that claims 1 – 25 as recited therein accurately reflect the 25 original claims presented in the subject application as filed. Furthermore, in reviewing the file wrapper of this application, Appellants have discovered that no “Amendment” had ever been filed during the prosecution of this application. The “Response” that was filed on January 18, 2005 was not intended to amend any of the claims, notwithstanding the fact that two claims (2 and 5) were erroneously presented in the Response. And although both were shown to be “(original)” they were in fact incorrect and did not accurately reflect the claims as originally filed in 2001. The Remarks on page 8 of that Response reveal that there was no intent to amend any of the claims. There is nothing in that Response that would indicate that any part of the application was being amended by that Response. But neither the examiner nor the Appellants had discovered this mistake until now. Since claims 2 and 5 as presented in the Response were clearly a mistake, the incorrectly presented claims should be ignored for purposes of this appeal.

Since Appellants’ attorney presented the 25 claims in the Third Appeal Brief appendix as they were originally presented in the initial application, there is nothing to correct as was ordered by the Board. Those are the correct claims now pending in this application and which, more importantly, stand rejected by the Examiner.

CONCLUSION

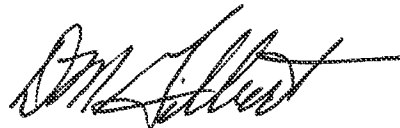
Accordingly Appellants request that the Appeal be returned to the Board and be reinstated for immediate action based upon the claim set appearing in the Claim Appendix of the Third Appeal

Brief. Appellants also request that the Order dated July 13, 2009 be vacated in its entirety in accordance with the remarks provided herein. Appellants attorney wishes to acknowledge and thank Chief Appeals Administrator, Dale Shaw, for his comments and suggestions made on August 11, 2009 in a phone interview with the undersigned attorney.

It is believed that no extensions of time or fees are required, but to the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 08-2025 and please credit any excess fees to such deposit account.

Respectfully submitted,

Joubert Berger, et al.



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Date: August 11, 2009

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